

REMARKS

Provisional Double Patenting

Claims 31, 33 and 34

Claims 31, 33 and 34 stand provisionally rejected under the judicially-created doctrine of obviousness-type double patenting as being allegedly unpatentable over claim 37 of copending U.S. Patent Application 08/253,843 ("the '843 application") and claims 31, 33 and 34 of copending U.S. Patent Application 08/449,930 ("the '930 application").

Applicant submits herewith two Terminal Disclaimers wherein the terminal portion of any patent granted on the instant application that would extend beyond the expiration date of any patent issuing from the '843 application or the expiration date of any patent issuing from the '930 application is disclaimed. These Terminal Disclaimers obviate the two obviousness-type double patenting rejections. Accordingly, this response satisfies 37 C.F.R. § 1.116. Applicant requests that the Examiner enter these Terminal Disclaimers and withdraw the rejections.

Submission of Documents From Pending Interferences

Applicant submits herewith a copy of the following documents from pending interferences that relate to recombinant interferon beta and its DNA:¹

- Decision of the Board of Patent Appeals and Interferences, Sugano v. Goeddel, Interference 105,334, Paper No. 109 (September 29, 2008)² (copy attached as Appendix A)

¹ Applicant submits concurrently herewith a form PTO/SB/08b listing these documents.

² The Examiner identified Interference 105,334 in co-pending application 08/449,930 in the "Related Appeals and Interferences" section of his August 17, 2007 Second Examiner's Answer. The parties in Interference 105,334 are junior party Sugano *et al.* (U.S. Patents 5,514,567 and 5,326,859) and senior party Goeddel *et al.* (U.S. Patent Application 07/374,311).

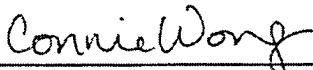
Appln. No. 08/452,658
Response dated June 5, 2009
Response to Final Office Action dated January 16, 2009

- Decision of the Board of Patent Appeals and Interferences, Sugano v. Goeddel, Interference 105,337, Paper No. 112 (September 29, 2008)³ (copy attached as Appendix B)
- Brief of Appellants Goeddel et al., in Goeddel v. Sugano, Appeal Nos. 2009-1156 and 2009-1157 (Fed. Cir. April 15, 2009) (copy attached as Appendix C)
- Sugano Opposition to Fiers Response to Order to Show Cause, Fiers v. Sugano, Interference 105,661, Paper 39 (May 6, 2009)⁴ as well as the accompanying Sugano Exhibits 1001-1020 (copy attached as Appendix D)

Conclusion

For all of the reasons set forth herein, applicant respectfully requests that all of the pending claims be allowed and that this application be passed to issue.

Respectfully submitted,



James F. Haley, Jr. (Reg. No. 27,794)
Connie Wong (Reg. No. 62,901)
Attorneys for Applicant
c/o ROPES & GRAY LLP
Customer No. 1473
1211 Avenue of the Americas
New York, NY 10036
Tel.: (212) 596-9000

³ The Examiner identified Interference 105,337 in co-pending application 08/449,930 in the "Related Appeals and Interferences" section of his August 17, 2007 Second Examiner's Answer. The parties in Interference 105,337 are junior party Goeddel et al. (U.S. Patent 5,460,811) and senior party Sugano et al. (U.S. Patent Application 08/463,757).

⁴ The parties in Interference 105,661 are junior party Fiers (U.S. Patent Application 08/471,646) and senior party Sugano et al. (U.S. Patent 5,326,859).